

### **REMARKS**

Claims 1-28 were originally filed in the present application. Claims 1-7 were subsequently canceled without prejudice or disclaimer, and new claims 29-35 were added. Claim 30 was subsequently canceled without prejudice or disclaimer. Claims 36-41 are currently added. Thus, claims 8-29 and 31-41 are currently pending in the present application.

Reconsideration of this application in light of the foregoing amendments and the following remarks is requested.

### **Comments Regarding Amendments to the Claims.**

#### **A. Claims are currently amended and added.**

Independent claims 8, 14, 22, and 29 are amended to more precisely claim the current method and device wherein a station notifies a non-emergency capability requestor that future requests for position information will similarly be denied.

Claim 8 is amended to clarify that the capability request response in the element that included the status indicator.

Claim 14 is amended to eliminate the non-distinguishing step of “receiving at a first station a capability request transmitted by a second station.” The operation of the second station in response to the capability request is enumerated for additional clarity. Claim 15, which is dependent on claim 14, is amended reflect indefinite presentation of the “capability request.”

Claim 22 is amended to enumerate potential non-emergency-services position-determination (NESPd) capabilities of the wireless mobile device.

Claim 29 is amended to eliminate the non-distinguishing step of “transmitting a non-emergency-services position-determination (NESPd) message to a mobile station.”

The newly added claims 36-41 are two (2) dependent claims to each of independent claims 8, 22, and 29, and specifically claim the manner the applicants disclose for including the status indicator, which provides the novel notification, in the capability request response.

**B. The original disclosure provides antecedent basis for all the amendments and additions.**

The amendments do not constitute new matter. The potential response to the capability request and NESPD capabilities enumerated in claims 14 and 22 are presented in paragraphs [0018] and [0027], in the structure of the status indicator, and in paragraphs [0037] and [0040] in the discussion of the disclosed method.

The original disclosure teaches in paragraph [0026] that the status indicator (120) can occupy one bit, which is shown to be in the same octet as the reserved bits (130). The original disclosure teaches in Figure 1 that there can be eight (8) reserve bits (130), and the last sentence of paragraph [0027] teaches that one or more of the reserved bits (130) could be used for the status indicator (120). The disclosure puts no limit on “more,” other than it cannot be more than the total number of reserved bits (130) the status indicator (120) may use.

**Rejections Under 35 U.S.C. §103**

Claims 8-29 and 31-35 were rejected under 35 U.S.C. §103 as being unpatentable over Havinis, et al. (US Pat. No. 6,311,069, hereinafter referred to as “Havinis”) in view of Zellner, et al. (US Pat. No. 6,675,017, hereinafter referred to as “Zellner”). Applicants traverse this rejection of all of the claims on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to the currently amended independent claims 8, 14, 22, and 29.

To establish a *prima facie* case of obviousness, [1] there must be some suggestion or motivation to modify the reference or combine the reference teachings; [2] there must be some reasonable expectation of success; and [3] the prior art must teach or suggest all the claim limitations. MPEP § 706.02(j). All three conditions are required for each claim to be considered *prima facie* obvious. It is submitted that in the present case the Examiner has not factually supported a *prima facie* case of obviousness, because the combination of Havinis and Zellner do not teach or suggest all the claim limitations of any of the present claims.

**The references do not teach or suggest all the claim limitations.**

An example of a claim limitation that the combination of Havinis and Zellner neither teaches nor suggests is that each current claim includes a status indicator. The status indicator “inform[s] the non-emergency services provider that non-emergency position-determining capabilities of the mobile device have been disabled.” Paragraph [0018]. Upon receiving this notice, the requestor can know the stations future intent to not provide position information.

The combination of Havinis and Zellner does not teach or suggest informing the requestor of the status of the system, which leaves the requestor to presume the request failed due to transmission failure, in either the request or the response. The combination only addresses a current request, which upon failure will result in additional futile requests being made by the requestor.

Zellner teaches a profile that permits elimination of redundant failed communication *internal* to the system, since the mobile station can instruct the base station to not provide location information, and the base station can act upon future requests with that instruction. But Zellner does not teach informing the requestor, so the requestor can cease sending requests. *See* column 2, line 65, to column 3, line 13. Zellner can not be seen to suggest or teach a status indicator, as currently claimed.

In Havinis, as described at column 6, line 23 to 27, the requestor receives a default response (17) from the system after a timer (19) expires prior to receiving a response from the mobile station (20). This process does not inform the requestor of the system’s status that will result in future non-responses. The requestor will most-likely continue to send requests, not knowing the system status will not permit a response. Havinis can not be seen to suggest or teach a status indicator, as currently claimed.


Since neither Havinis nor Zellner teach or suggest the teaching of the current disclosure, contained in the current claims, the combination of Havinis and Zellner can not appropriately form the basis for a *prima facie* case of obviousness.

**CONCLUSION**

The foregoing shows that independent claims 8, 14, 22 and 29 are in condition for allowance. Dependent claims 9-13, 15-21, 23-28 and 31-41 depend from and further limit independent claims 8, 14, 22 and 29 and, therefore, are allowable as well.

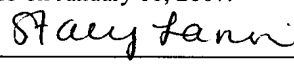
It is believed that all matters set forth in the Office Action have been addressed, and that claims 8-29 and 31-41 are in condition for allowance. Favorable consideration and an early indication of the allowability of the claims are respectfully requested. Should the Examiner deem that an interview with Applicants' undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

  
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Dated: January 10, 2007

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<p><b>Certificate of Service</b></p> <p>I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on January 10, 2007.</p> <p> Stacy Lanier</p>
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